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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,277	07/01/2003	Marc Haci	P 061459 303137	5785

34010 7590 11/29/2005

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EXAMINER

BATES, ZAKIYA W

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/612,277

Applicant(s)

HACI ET AL.

Examiner

Zakiya W. Bates

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 and 48-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41-46 and 48-61 is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-11, 20-26, and 28-31 is/are rejected.
- 7) ☒ Claim(s) 8, 12-19, 27 and 32-40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-7, 9-11, 20-26, and 28-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Eppink et al. (previously cited).

Eppink et al. discloses a method that includes, with respect to claim 1, a method of drilling a borehole, comprising: alternating between rotary drilling and sliding drilling using a steerable drilling motor while a drill bit remains in substantially continuous contact with a bottom of said bore hole, said steerable drilling motor being connected by a drill string to a surface drilling location. See column 5, lines 1-21 and figures 17-19 and 35-39. With respect to claim 20, the reference discloses a method of drilling a bore hole, comprising rotating and advancing a drill string having a steerable motor connected thereto in said bore hole, said drill string having a bit at a bottom end thereof; said bit being in contact with a bottom of said well: bore, thereby drilling in a rotary mode; after drilling in said rotary mode, stopping rotation of said drill string and continuing to advance said drill string with said bit in substantially

continuous contact with said bottom, thereby drilling in a sliding mode. With respect to the depending claims, the reference teaches the limitations as claimed.

Allowable Subject Matter

3. Claims 8, 12-19, 27, and 32-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
4. Claims 41-46 and 48-61 are allowed.

Response to Arguments

5. Applicant's arguments filed 9/15/05 have been fully considered but they are not persuasive. Applicant does not agree that the drill system of Eppink et al. alternates between a drilling mode and a sliding mode without lifting the bit, or "while the bit remains in substantially continuous contact with a bottom of said borehole" as called for in the claims. However, the system of Eppink et al. uses upper and lower stabilizers to change direction of the bit, which does not require lifting (see col. 4, line 36- col. 5, line 21). Further, see particularly Figs. 37-39 for a system having a steerable motor 274, where adjustable stabilizer blades 40, 42 (operation of which can be found in col. 14, line 43- col. 15, line 30) are remotely operated to extend/contract in order to change direction. The bit 272 is not "lifted" from the bottom of the borehole, and therefore remains in substantially continuous contact with the borehole bottom. Figs. 31-32 also

show a system having a steerable motor and adjustable blades for changing bit direction.

Conclusion


6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zakiya W. Bates (formerly Zakiya Walker) whose telephone number is (571) 272-7039. The examiner can normally be reached on Monday-Friday, 8:30 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Zakiya W. Bates
Primary Examiner
Art Unit 3676

zb
November 22, 2005